

REMARKS

As an initial matter, Applicants request that the Amendment After-Final filed on July 7, 2004 NOT be entered.

In the final Office Action, the Examiner rejected claims 24 and 25 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter of the invention; rejected claims 1-4, 6, 7, 10, 24 and 25 under 35 U.S.C. 103(a) as being unpatentable over Hottendorf (U.S. Patent No. 3,654,038) in view of Morel et al. (U.S. Patent No. 4,783,054); rejected claim 8 under 35 U.S.C. 103 as being unpatentable over Hottendorf and Morel et al. as applied to claim 3 and further in view of Talalay (U.S. Patent No. 4,504,336) and DuFresne (U.S. Patent No. 2,931,751); rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over Hottendorf and Morel et al. as applied to claim 1 and further in view of Lindstrom et al. (U.S. Patent No. 4,321,103); rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over Hottendorf and Morel et al. as applied to claim 3 and further in view of Heuser et al. (U.S. Patent No. 3,698,296) and Hoover (U.S. Patent No. 2,325,400); and rejected claims 12 through 14 under 35 U.S.C. 103(a) as being unpatentable over Hottendorf and Morel et al. as applied to claim 1 and further in view of Miyajima et al. (U.S. Patent No. 6,321,813), Farfaglia et al. (U.S. Patent No. 3,847,540), Sbrana (U.S. Patent No. 5,972,151) and Heuser et al.

By this Amendment, Applicants have cancelled claims 1, 9, and 25 without prejudice or disclaimer; amended claims 2-4, 6-8, 10-15, and 24 to more appropriately define the present invention; and added new claim 28. Claims 2-4, 6-8, 10-14, 24, and 28 are pending in the above-captioned patent application.

At the outset, Applicants note that cancelled claim 1 has been rewritten as new claim 28, and the dependencies of claims 2-4, 6, 10, 12 and 24 have been changed accordingly.

Applicants respectfully traverse the Examiner's rejection of claim 24 under 35 U.S.C. §112, second paragraph. However, in order to expedite prosecution of the present application, claim 24 has been amended to depend from one of claims 2-4, 6-8, 10-14, or 28, and recites that "the segments of the sheet are suitably positioned by the device to maintain a gap between adjacent tiles," thereby rendering the Examiner's rejection moot. Accordingly, Applicants respectfully submit that claim 24 satisfy the requirements of 35 U.S.C. §112, second paragraph.

Applicants respectfully traverse the Examiner's rejection of claims 1-4, 6, 7, 10, 24 under 35 U.S.C. 103(a) as being unpatentable over Hottendorf in view of Morel et al. The Examiner's rejection is moot with respect to cancelled claim 1. Moreover, to the extent that the Examiner's rejection is applicable to new claim 28, Applicants submit that new claim 28 is not obvious over Hottendorf and Morel et al. because neither reference teaches or suggests each and every element of the claim. In particular, Hottendorf and Morel et al. at least fail to teach or suggest the claimed combination including "a device for producing panels of mosaic tesserae having at least a supporting and/or lining sheet on a visible face of said tesserae arranged inside an advancing frame," "clamping means to block the suction force at least for a section of the drum surface facing a conveyor belt, and for an amplitude to substantially cover the size of the frame," "a pressure roller contacting said one of said sheet segments released from said suction drum rotating means," and drum rotating means.

Hottendorf teaches a box taping machine for taping and folding paperboard box blanks, wherein a strip of tape is applied to one side edge of a box blank, not a device for producing panels of mosaic tesserae, as recited in claim 28. Although Hottendorf discloses a pressure wheel (108) and a series of rollers (109) that apply tape to the box, the reference is silent as to “a pressure roller contacting said one of said sheet segments released from said suction drum rotating means” (see col. 2, lines 60-65; and Fig. 1). In addition, Hottendorf teaches the use of a baffle (107) mounted within taping wheel (82) to cut off suction in the upper right quarter of the taping wheel (82) (see col. col. 2, lines 55-60), but fails to disclose “clamping means to block the suction force for a section of the drum surface facing a conveyor belt” (emphasis added). Moreover, Hottendorf discloses taping wheel 82 spaced from, but not facing, belts 80 (see Fig. 1). Accordingly, Hottendorf also does not teach or suggest the claimed “section of the outer cylindrical surface facing a conveyor belt,” as recited in claim 28.

Morel et al. discloses a pneumatic device for fitting cables in a tube (col. 1, lines 5-7), but also at least fails to disclose the claimed combination including a “device for producing panels of mosaic tesserae,” and “clamping means to block the suction force for a section of the drum surface facing a conveyor belt, and for an amplitude to substantially cover the frame.” In addition, Morel et al. is also silent as to the claimed “pressure roller contacting said one of said sheet segments released from said suction drum rotating means,” as recited in claim 28.

Both Hottendorf and Morel et al. are also silent as to the claimed “rotating means configured to be lowered ... such that ... said suction drum is lowered back when a next incoming frame is in a suitable position ... said suitable position corresponding to a

location *a few millimeters* from the perimeter of said advancing frames” (emphasis added).

Morel et al. teaches a clamping mechanism that completely blocks the flow of pressurized air from a source (col. 3, lines 31-34). Although the Examiner contends in the Advisory Action that one of ordinary skill in the art would recognize how to replace the function of the Hottendorf baffle with an air flow clamping mechanism such that the pressurized air flow is terminated only in the area where the sheet segment is to be released. The Morel et al. teachings relied upon by the Examiner do not teach or suggest discontinuing suction in a specific location of the taping wheel (82). Moreover, the Examiner has not established that one of ordinary skill would recognize how to replace the function of the baffle with an air flow clamping mechanism to “block the suction force [in]...a section of the drum surface facing a conveyor belt, and for an amplitude to substantially cover the size of the frame.” The Examiner has failed to provide a reference that teaches the use of a clamping mechanism to block suction in a section of a drum and for an amplitude to substantially cover the size of the frame, as recited in claim 28. Thus, Morel et al. fails to overcome the above-described deficiencies of Hottendorf, and claim 28 is not obvious over the Examiner’s proposed combination of references.

In addition, Hottendorf and Morel et al. constitute non-analogous art. Prior art references, in order to be properly applied, must either be in the field of Applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which Applicants were concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), and MPEP §2141.01(a). Hottendorf and Morel et al., however, relate to

subject matter entirely unrelated to the subject matter recited in claim 28. Hottendorf relates to an "box taping machine," wherein the reference discloses a machine for taping and folding paperboard box blanks. In contrast, the Morel et al. reference discloses a pneumatic device for fitting cables in a tube. Morel et al. teaches a clamping mechanism that completely blocks the flow of pressurized air from a source, and if combined with the Hottendorf reference, would render the Hottendorf device unsatisfactory for its intended purpose by completely eliminating suction and permitting subsequent tape segments (106) to fall from wheel (82) every time the suction was completely blocked (see Morel et al. col. 3, lines 32-35). Additionally, since neither reference relates whatsoever to a device for producing panels of mosaic tesserae as recited in new claim 28, Applicants submit that one of ordinary skill in the art would not combine these references in order to obtain the combination recited in new claim 28.

In light of the above-described deficiencies of both Hottendorf and Morel et al., Applicant's submit that claim 28 is allowable over the applied references, and claims 2-4, 6, 7, 10, and 24 are allowable at least due to their dependence from claim 28.

Applicants respectfully traverse the rejection of claim 8 under 35 U.S.C. 103 as being unpatentable over Hottendorf and Morel et al. as applied to claim 3 and further in view of Talalay and DuFresne. Talalay and DuFresne fail to disclose the claimed combination including a means to deliver steam or nebulized water arranged in cooperation with the visible face of said mosaic tesserae, said means to deliver being configured to deliver a jet against said face to reactivate the gluing means on said sheets. However, even if Talalay and DuFresne teach what the Examiner alleges (and Applicants disagree that they do), the references still fail to overcome the shortcomings

of Hottendorf and Morel et al. discussed above. Therefore, claim 8 is allowable at least due to its dependence from claim 28.

Applicants respectfully traverse the rejection of claim 9 under 35 U.S.C. 103(a) as being unpatentable over Hottendorf and Morel et al. as applied to claim 28 and further in view of Lindstrom et al.

Insofar as the Examiner's rejection of claim 9 is relevant to amended claim 28, Applicants note that Lindstrom et al. is directed toward a mechanism for applying merchandising labels to packages. The Examiner relies on Lindstrom et al. allegedly for teaching "means for alternately lifting and lowering the label applying roller in synchronism" (Office Action at page 6). Applicants respectfully disagree with the Examiner that such teachings, even if present in Lindstrom et al. are combinable with Hottendorf and Morel et al. in the matter set forth at page 6 of the Office Action. In any event, Lindstrom et al., like Hottendorf and Morel et al., also fails to teach "rotating means configured to be lowered ... such that ... said suction drum is lowered back when a next incoming frame is in a suitable position ... said suitable position corresponding to a location *a few millimeters* from the perimeter of said advancing frames" (emphasis added) as recited in claim 28. Accordingly, Lindstrom et al. also does not overcome the above-described deficiencies of Hottendorf and Morel et al.

Applicant's respectfully traverse the rejection of claim 11 under 35 U.S.C. 103 as being unpatentable over Hottendorf and Morel et al. and further in view of Heuser et al. and Hoover; and the rejection of claims 12-14 as being unpatentable over Hottendorf and Morel et al. in view of Miyajima et al. etc. Each of Heuser, Hoover, Miyajima et al., Farfaglia et al., and Sbrana is silent as to the claimed "a device for producing panels of

mosaic tesserae having at least a supporting and/or lining sheet on a visible face of said tesserae arranged inside an advancing frame," "clamping means to block the suction force at least for a section of the drum surface facing a conveyor belt, and for an amplitude to substantially cover the size of the frame," and "a pressure roller contacting said one of said sheet segments released from said suction drum rotating means," and "drum rotating means." Accordingly, Heuser, Hoover, Miyajima et al., Farfaglia et al., and Sbrana also fail to remedy the shortcomings of Hottendorf and Morel et al. discussed above, and 11-14 are thus allowable at least due to their dependence from claim 28.

CONCLUSION

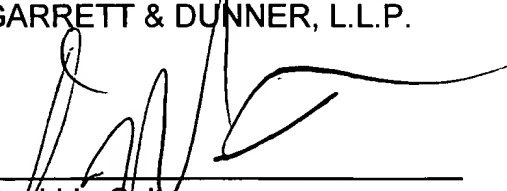
In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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